

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: Brian P. Yenke
ARATANI, ET AL.)
: Group Art Unit: 2622
Application No.: 09/987,569)
: Confirmation No. 7348
Filed: November 15, 2001)
:
For: APPARATUS AND METHOD WITH)
RECEIVING OF BROADCAST DATA :
SIGNAL, COMMUNICATING WITH)
EXTERNAL DEVICE, AND :
CONTROLLING IMAGE TO BE)
DISPLAYED IN ACCORDANCE WITH :
COMMUNICATION) August 26, 2008

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Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF ON APPEAL

Sir:

This is a Reply Brief in response to the Examiner's Answer dated June 26, 2008.

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I. Status of Claims

Claims 46-61 stand finally rejected. Claims 1-45 are cancelled. Appellants are appealing the rejection of Claims 46-61.

II. Summary of Claimed Subject Matter

A summary of the claimed subject matter (both independent and dependent claims) is provided in the Appeal Brief, as required; however, for the Board's convenience a summary of the independent claims is provided below.

a. Independent Claim 46

Independent Claim 46 is generally directed to a television receiving apparatus which is (a) connected to a printer in a manner to allow the apparatus to communicate with the printer and (b) capable of sending to the printer data obtained from contents data having been sent multiplexed in a broadcast. The receiving apparatus extracts document data which is described in a markup language and included in the contents data.

The document data includes (a) a script for acquiring status information of the printer and (b) a plurality of status display information. Display image data is generated using the document data extracted by the extracting means. Executing means executes a process for acquiring the status information of the printer and has means for executing the script. In addition, in accordance with the acquired status information, the executing means executes a process for identifying status display information indicating a status of the printer from the plurality of status display information included in the document data. This status display information is reflected in the generated display image data.

b. Independent Claim 51

Independent Claim 51 is directed to a television signal receiving method for use with a printer. The method includes a step of extracting document data which is described in a markup language and included in contents data. The contents data is sent multiplexed in broadcast by a broadcast apparatus.

The document data includes (a) a script for acquiring status information of the printer and (b) a plurality of status display information. The method also generates display

image data which can be displayed on a display unit, using the document data.

In addition, the method executes a process for acquiring the status information of the printer as well as a process for, in accordance with acquired status information, identifying status display information indicating a status of the printer from the plurality of status display information. That executing step also executes the script. The display image data reflects the status display information identified in the executing step.

III. Grounds of Rejection To Be Reviewed On Appeal

Whether Claims 46-61 should be rejected under 35 U.S.C. § 103 over U.S. Patent Application Publication No. 2003/0164976 (Ihara et al.) in view of U.S. Patent No. 6,426,778 (Valdez, Jr.) and Appellants' own specification, given various deficiencies in the bases for the rejection. In particular, Appellants ask review of whether the reliance on Ihara et al. and Valdez, Jr. is proper in view of the fact that neither document suggests the inclusion of a script and a plurality of status display information in a broadcast signal or the use of the same in the manner recited in the claims.

In addition, Appellants ask review of whether the reliance on Appellants' own specification is proper where the cited sections of the specification either do not recite the features for which they are relied upon or are directed to the Appellants' *own* embodiments.

IV. Argument

A. Summary

The Examiner's obviousness rejection is predicated upon the combination of Ihara et al. and Valdez, Jr. The Examiner takes the position that Ihara et al. describes a system that receives a broadcast and converts data in the broadcast pursuant to the IEEE 1394 Standard in connection with a printing operation. The Examiner acknowledges that Ihara et al. does not describe the broadcast of a markup language including contents data. The Examiner takes the position that Valdez, Jr. describes the use of a markup language in a broadcast, and thus remedies the deficiencies of Ihara et al.

The problem, however, is that neither Ihara et al. nor Valdez, Jr. describes or suggests that the content of a broadcast includes a script for acquiring the status of a printer and a plurality of status display information for indicating the acquired status.

As discussed in the Appeal Brief, the Examiner improperly tries to correct this deficiency using conclusory statements not supported by the evidence, the Appellants' own discussion of their invention, and assertions that the invention must be obvious in view of the communication standard used to implement it.

In the Examiner's Answer, those same errors are repeated. Primarily, the Examiner again relies on Appellants' own invention as evidence of obviousness. Furthermore, the Examiner concludes, without citation to specific evidence, that the invention is obvious in view the communication standard which could be used to implement it. These arguments fail for the reasons set forth below.

B. Discussion

In one aspect, the present invention relates to systems and methods of interconnecting an apparatus for receiving a television signal and a printer such that (1) document data provided in a broadcast signal may be used in communicating with the

printer and (2) information relating to the communication with the printer may be displayed to a viewer. In particular, independent Claims 46 and 51 generally recite that document data provided in the broadcast signal includes both (a) a script for use in acquiring status information from the printer and (b) a plurality of status display information for use in indicating the status of the printer based on the acquired information.

Thus, in the present invention, a television broadcast provides both the script to query a printer concerning its status and the status information that is displayed to a user based on the result of status inquiry.

As discussed in Appellants' specification, conventional systems suffered from the problem that computers used for storing and printing data required that software programs already be installed therein to properly execute status checks of the printer and display the results thereof. *See* Appellants' specification, ¶ 0011. Furthermore, with respect to the broadcasting of content data using a television signal, print content and display content were independently handled in the systems, which limited functionality. *See* Appellants' specification, ¶ 0013. The present invention overcomes the deficiencies of the conventional systems by providing in a television broadcast both the script for acquiring status information of a printer and the actual status display information to be displayed concerning the printer.

Neither Ihara et al. nor Valdez, Jr. suggest these features of Appellants' invention. Specifically, Ihara et al. merely describes a set top box 3 that receives a broadcast signal. That document does not describe, as the Examiner acknowledges, that a broadcast received by the set top box 3 includes both a script for acquiring status information of a printer and a plurality of status display information to be displayed in response to the acquired status. Valdez, Jr. describes that a broadcast may include a markup language. The Examiner's rejection suggests that the disclosure of the broadcast of markup language is sufficient to render obvious the invention. However, Valdez, Jr. does not disclose that the markup

language includes both a script for acquiring status information of a printer and the status display information to be displayed based on the acquired status. Thus, Valdez, Jr. suffers from the same deficiencies as Ihara et al.

The Examiner as much as admits these deficiencies in the cited references. Nevertheless, in the Examiner's Answer (and in the rejection on appeal) the Examiner attempts to surmount these fatal defects in two ways.

First, the Examiner relies on Appellant's own discussion of the invention as a basis for supplementing the shortcomings of Ihara et al. and Valdez, Jr.

Second, the Examiner appears to take the position that because the invention could be implemented using an existing communication standard the claimed communication must be obvious.

Neither position constitutes a proper basis for maintaining a rejection under 35 U.S.C. §103, for the reasons discussed below.

1. The Examiner's Reliance on Appellants' Own Disclosure is Inappropriate

It is well established that "[k]nowledge of applicant's disclosure must be put aside The tendency to resort to 'hindsight' based on applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP 2142.

As discussed in the Appeal Brief, the Examiner relied on paragraphs of Appellants' own specification in the Office Actions to remedy the deficiencies in the applied references. In fact, Appellants' noted in the Appeal Brief that over half of the paragraphs cited to by the Examiner in rejecting the present claims are discussions of actual embodiments of Appellants' own invention. (Paragraphs 0057, 0059, 0068, and 0080

relied on by the Examiner are in the Description of the Preferred Embodiments section of the application.)

The Examiner's Answer suffers from the same defects. Specifically, in the Response section of the Examiner's Answer, three separate response arguments are provided. *See Examiner's Answer, page 6. Every one of the three response arguments relies on Appellants' own disclosure of the invention to make the case for obviousness.*

In the Examiner's first response argument (labeled "a"), he acknowledges that Ihara et al. does not explicitly recite receiving script information in the received broadcast signal. To surmount this problem, the Examiner states that "Appellant's disclosure (para 0056) states that the broadcast data includes text information, script information, display information, print layout information etc." Examiner's Answer page 6, paragraph (a). As has been clearly explained to the Examiner, paragraph 0056 is a discussion of one embodiment of Appellants' own invention. It is not a discussion of prior art.

Specifically, that paragraph states that display layout information and print layout information are supplied in a broadcast data signal because it is the Appellants' invention to do so. Furthermore, as discussed in the Appeal Brief, an Examiner may cite to an applicant's description of prior art in a rejection when the sections relied on by the Examiner are *admitted* to be prior art. *See* MPEP 2129. Appellants make no such admission with respect to paragraph 0056. Consequently, the Examiner's response argument in paragraph (a) of page 6 is simply improper.

The Examiner's second response argument (paragraph "b" of page 6 of the Examiner's Answer) argues that the portions of Appellants' own specification relied on by the Examiner discuss the use of a communication standard (ISO/IEC Standard 13818-6). As discussed in more detail below, that a communication standard may be used to implement the invention does not automatically render obvious the invention. Furthermore, the Examiner's second response argument goes on to state that "the invention

discloses executing this script”. Examiner’s Answer, page 6, paragraph (b). The Appellants’ cannot make this point more forcefully – *the Appellants’ own invention cannot be prior art against itself*.

The Examiner’s final response argument (paragraph “c” of page 6) notes “that the Appellants’ disclosure states that the script and plurality of status display information is received via a broadcast, thus the information is included in the received signal.” Again, of course the Appellants’ own disclosure describes that the script and plurality of status display information are received via a broadcast – that is part of Appellants’ invention. Any discussion of the same in the specification is a discussion of an embodiment of the Appellants’ invention and not an admission of prior art.

Moreover, Appellants’ specification makes clear that the inclusion of a script for acquiring status information of the printer and a plurality of status display information in a broadcast signal overcomes deficiencies in the prior art. Specifically, the specification describes that conventional systems cannot easily print out broadcast data received at a personal computer by simply storing the data and then printing the data using a dedicated application program. *See* ¶ 0010. Instead, the computer often needs to be prepared with required software programs to handle the printing communications between the broadcast receiver and the printer. *See* ¶ 0011. The present invention attempts to address these deficiencies. Specifically, the present invention overcomes the limited functionality of the conventional systems by providing in the broadcast signal both the script for acquiring status information of a printer and the status display information to be displayed based on the acquired status.

Yet, despite these clear discussions in the specification, the Examiner relies on the Appellants’ discussion of their novel solution as prior art to itself. Appellants’ do not admit its solutions to the problems of conventional systems are prior art, and thus, the Examiner cannot base his rejection on the Appellants’ discussions of the same.

“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). That all three of the Examiner’s response arguments in the Examiner’s Answer rely on Appellants’ own specification underscores the deficiencies of the rejection.

2. The Use of A Communication Standard Does Not Render Obvious Any Communication Performed Using the Standard

The second major flaw of the Examiner’s Answer is that the Examiner seems to take the position that use of a communication standard renders unpatentable any invention that is implemented using the standard. In fact, in discussing the ISO-IEC Standard 13818-6, the Examiner states that “a system that can receive ... script/broadcast data could then execute the script data ... and carry out the operations.” Examiner’s Answer, page 6, paragraph (b). That a system can or could perform the functions of the invention is not evidence that the invention itself is obvious. It is well established that the mere fact that the claimed invention would be within the capability of one skill in the art is not enough to establish obviousness. See MPEP 2143.01(IV). Even with the Supreme Court’s recent decision in *KSR International*, the law still requires that there be a *reason* to modify the prior art to establish obviousness. See *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, slip opinion at 14 (2007). Appellants are not aware of any precedent that states that obviousness can be based upon an assertion that the claimed invention *could* be implemented using the prior art.

The standard discussed in the specification is merely a communication standard for communicating digital data. It is the Examiner’s position that the capability of the standard to communicate digital data would render obvious the claimed communication

content and process. To accept the Examiner's position would be to find that any invention implemented using a communication standard would be obvious in view of the standard itself. Consequently, any inventor who develops a new digital invention would simultaneously have to invent a new means of communicating the digital data, lest the invention would be found unpatentable in view of the existing digital communication standard. This position undermines the very purpose for communication standards themselves.

That computers and printers may communicate using an existing standard does not automatically render it obvious to provide specific information in a television broadcast signal, in a specific manner, such that the broadcast data may be printed without the need for the computer to be previously provided with particular programs for handling the printing operation. Moreover, the Examiner has provided no evidence to establish what, if anything, in the standard renders obvious the invention. Instead, the examiner relies on conclusory statements asserting that the invention is unpatentable because the communication could take place using the standard. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Moreover, it is Appellants's position that the standard itself does not describe or suggest the specific functionality recited in independent claims, namely, that a television broadcast signal includes both a script for acquiring status information of a printer and a plurality of status display information for displaying the acquired status. The Examiner has provided no citation to suggest otherwise. In fact, the record does not even suggest that the Examiner obtained or reviewed an applicable communication standard.

Consequently, the admitted failures of Ihara et al. and Valdez Jr. cannot be remedied by either of citations to Appellants' own description of the invention or a

communication standard which could be used to implement the novel aspects of the invention.

C. Dependent Claims

Appellants would like to remind the Board that several dependent claims are discussed in the Appeal Brief. These dependent claims have not been specifically addressed by the Examiner in the Examiner's Answer and Appellants maintain that those dependent claims further define novel aspects of the present invention.

D. Conclusion

For the reasons discussed above, Appellants submit that the Examiner's reliance on Appellants' own embodiments and the assumption that the invention is obvious in view of the communication standard on which it may be implemented is improper.

Moreover, Appellants assert that the Examiner has failed to establish that the communication standard or Appellant's discussion of any conventional system specifically discloses or suggests that document data provided in the broadcast signal includes both (a) a script for use in acquiring status information from the printer and (b) a plurality of status display information for use in indicating a status of the printer based on the acquired information.

Furthermore, Appellants wish to ensure that it is not lost on the Board that the Examiner's Answer, when forced to respond to the rejection, did not even attempt to argue that the applied references (Ihara et al. and Valdez, Jr.) actually describe the above-discussed features of the present invention. Instead, the Examiner reached for arguments based on Appellants' own disclosure and the communication standard. Appellants take this as acknowledgment that the applied references do not suggest the features of the present invention.

For the foregoing reasons, Appellants respectfully submit that the 35 U.S.C.
§ 103(a) rejection of record is deficient and request reversal of the rejection.

Respectfully submitted,



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